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EXAMINER
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HENNING, MATTHEW T

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2131

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/676,319	Applicant(s) BRICKELL ET AL.	
	Examiner Matthew T Henning	Art Unit 2131.	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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This action is in response to the communication filed on 09/28/2004.

### **DETAILED ACTION**

1. Claims 1-41 have been examined.
2. All objections and rejections not specifically addressed below have been withdrawn.

#### ***Title***

3. The title of the invention is acceptable.

#### ***Priority***

4. No claim for priority has been made for this application.
5. The effective filing date for the subject matter defined in the pending claims in this application is 09/29/2000.

#### ***Information Disclosure Statement***

6. The information disclosure statement (IDS) submitted on 01/12/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

#### ***Drawings***

7. The drawings filed on 09/29/2000 are acceptable for examination proceedings.

#### ***Specification***

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:
  9. Claims 1-5, 13-15, 18-22, 25-27, and 38-41 recite the limitation of a registration status of the user indicating whether the user is in compliance with one or more requirements of a

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registration authority. There is insufficient antecedent basis in the specification for this limitation, as discussed below in the 35 USC 112 Section.

10. Claims 6-12, and 28-32 recite the limitation of the registration status of the user indicative of whether the user is authorized to perform one or more restricted activities. There is insufficient antecedent basis in the specification for this limitation, as discussed below in the 35 USC 112 Section.

11. Claims 16-17 recite the limitation of the registration status of the user indicating that the user is authorized by a registration authority for licensed professionals to access restricted information on the remote server. There is insufficient antecedent basis in the specification for this limitation, as discussed below in the 35 USC 112 Section.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-22, 25-32, and 38-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

14. Regarding claims 1-5, 13-15, 18-22, 25-27, and 38-41, the newly added limitations regarding whether the user is in compliance with one or more requirements of a registration

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authority lacks support from the specification. Specifically, the specification did not disclose any information regarding the requirements or how it would be determined if the user was in compliance with them. As such, one skilled in the art would not have been able to make the invention, as one skilled in the art would not know what the requirements of a registration authority are, or how to determine if the user is in compliance with them. Therefore, claims 1-5, 13-15, 18-22, 25-27, and 38-41 fail to meet the enablement requirement, and are therefore rejected.

15. Regarding claims 6-12, and 28-32, the newly added limitations regarding the registration status indicating whether the user is authorized to perform one or more restricted activities lacks support from the specification. Specifically, the specification did not disclose the status indicating this information, or what the one or more restricted activities include. As such, one skilled in the art would not have been able to make the invention, as one skilled in the art would not know how the registration status is linked to the user being authorized to perform restricted activities, or what the restricted activities include. Therefore, claims 6-12, and 28-32 fail to meet the enablement requirement, and are therefore rejected.

16. Regarding claims 16-17, the newly added limitations regarding the registration status indicating whether the user is authorized to access restricted information lacks support from the specification. Specifically, the specification did not disclose the status indicating this information. As such, one skilled in the art would not have been able to make the invention, as one skilled in the art would not know how the registration status is indicative of the user being authorized to access restricted information. Therefore, claims 16-17 fail to meet the enablement requirement, and are therefore rejected.

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17. Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 Line 2 recites the limitation “substantially” and is therefore rejected. This is because one of ordinary skill in the art could not how often is comprised by “a substantially regular basis” and therefore would not be able to determine the scope of these claims.

See MPEP § 608.01(i).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

19. Claims 1-5, 13-17, 25-27, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over French et al. (US Patent Number 6321339) hereinafter referred to as French, and further in view of Sheehan et al. (US Patent Number 6,311,163) hereinafter referred to as Sheehan, and further in view of State of Colorado (Senate Bill 97134 LLS NO. 970530.01) hereinafter referred to as Colorado.

20. Regarding claim 1, French disclosed receiving registration information associated with a user, indicative of the identity of the user (See French Fig. 1 Elements 16, 18, and 20 and Col. 12

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Paragraph 7), verifying at least some of the registration information (See French Fig. 1 Elements 32 and 40), issuing digital credential to user based on result from verification (See French Fig. 3 Elements 314 and 318), and communicating at least some of the registration information to a central authentication service (See French Col. 5 Paragraph 8 – Col. 6 Paragraph 2). However, French failed to disclose that the registration information included a registration status of the user indicating whether the user is currently in compliance with one or more requirements of a professional registration authority.

Sheehan teaches a system for a prescribing party to issue a prescription through a communication network such as the Internet, in which the prescribing party includes doctors, health service providers, and other authorized personnel (See Sheehan Abstract and Col. 4 Lines 47-49). However, Sheehan failed to disclose a method for ensuring that the prescribing party was in fact authorized to issue prescriptions.

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Sheehan in the authentication system of French by issuing certificates to authorized prescribing parties. This would have been obvious because the ordinary person skilled in the art would have been motivated to protect patients against illegally issued prescriptions.

Colorado teaches that in order to write a prescription in the state of Colorado, an advanced practice nurse must be listed on the advanced practice registry, have a license in good standing without disciplinary sanctions, and have fulfilled requirements established by the board (See Colorado Section 7).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Colorado in the prescribing party authorization system of French and Sheehan by checking the standing of the medical license of the party, whether they are registered on the advance practice registry, and the status of fulfillment of the requirements established by the board. This would have been obvious because the ordinary person skilled in the art would have been motivated to ensure that all legal requirements for issuing prescriptions were fulfilled prior to issuing an authorization certificate.

21. Regarding claim 2, the combination of French, Sheehan, and Colorado disclosed logging a transaction record of data sent to and from the authorization database (See French Col. 5 Paragraph 6)

22. Regarding claim 3, the combination of French, Sheehan, and Colorado disclosed uploading client software to the user's computer in order to provide real-time authentication (See French Col. 6 Paragraph 7).

23. Regarding claim 4, the combination of French, Sheehan, and Colorado disclosed generating a confirmation level based on the verification of the registration information (See French Col. 2 Paragraph 3), wherein the confirmation level is a: first confirmation level if the user is currently in compliance with at least a first requirement of the one or more requirements, and wherein the confirmation level is a second different confirmation level if the user is currently in compliance with at least a second different requirement of the one or more requirements (See French Figs. 3 Element 314 wherein a lower or higher confirmation is provided depending on the matching of the non-wallet type of information, such as the standing of the medical license, and requirements of the board).



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24. Regarding claim 5, the combination of French, Sheehan, and Colorado disclosed verifying a currently valid medical license number (See rejection of claim 1 above).

25. Regarding claim 13, the combination of French, Sheehan, and Colorado disclosed initiating a challenge response sequence from a client computer when a user uses a digital credential (See French Fig. 1 Element 12), the digital credential including information indicative of an identity of the user, the digital credential further indicative of user compliance with one or more requirements of a registration authority for licensed professionals (See French Fig. 41 and rejection of claim 1 above), receiving a challenge from a remote server (See French Fig. 1 Element 14), recites responding to the challenge using the digital credential (See French Fig. 1 Elements 16, 18, 20, and 22).

26. Regarding claim 14, the combination of French, Sheehan, and Colorado disclosed accessing the registration authority to receive the digital credential (See French Fig. 31), and wherein user compliance with one or more requirements of a registration authority comprises user compliance with one or more licensing requirements of the registration authority (See Colorado Section 7 and rejection of claim 1 above).

27. Regarding claim 15, the combination of French, Sheehan, and Colorado disclosed forwarding the digital credential to a central authentication service in response to the challenge received from the remote server (See French Col. 5 Paragraph 8 – Col. 6 Paragraph 2).

28. Regarding claim 16, the combination of French, Sheehan, and Colorado disclosed a browser configured to access a remote server (See French Col. 5 paragraph 4), and a plug-in module executed by the browser to cause the server to initiate a challenge response sequence when a user uses a digital credential (See French Col. 6 Paragraph 7 and Fig. 31 wherein French

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disclosed the use of Java applets in the authentication process to challenge for user information) including information indicative of a status of the user indicating that the user is authorized by a registration authority for licensed professionals to access restricted information on the remote server (See rejection of claim 1 above and Sheehan Col. 3 Lines 36-44).

29. Regarding claim 17, the combination of French, Sheehan, and Colorado disclosed the plug-in being a java applet (See French Col. 6 Paragraph 7).

30. Regarding claim 25, the combination of French, Sheehan, and Colorado disclosed an authentication server (See French Fig. 12 Element 120) in communication with a database (See French Fig. 12 Element 152), in which the database stores user input from a registration authority (See French Fig. 12 Element 130), for licensed professionals, the registration information indicative of compliance with one or more requirements of the registration authority (See rejection of claim 1 above); and the authentication server verifies the information in the database (See French Col. 5 Paragraph 6 and Col. 6 Paragraph 5).

31. Regarding claim 26, the combination of French, Sheehan, and Colorado disclosed the authentication server receiving a digital credential from a relying party (See French Col. 11 Paragraph 4).

32. Regarding claim 27, the combination of French, Sheehan, and Colorado disclosed verifying an identity of a user based on the digital credential, a registration status of the user with the registration authority for licensed professionals, wherein the registration status of the user is indicative of compliance of at least a first requirement of the one or more requirements, and authenticating the digital credential based on the verifications (See French Fig. 1 Elements 32, 34, and 38 and rejection of claim 1 above).

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33. Regarding claim 38, the combination of French, Sheehan, and Colorado disclosed creating a digital credential based on information received from a registration authority for licensed professionals where the information includes both information of the identity of a user and information indicative of compliance by the user with one or more regulations (See rejection of claim 1 and further French Col. 2. Paragraph 10 – Col. 3 Paragraph 1).

34. Regarding claim 39, the combination of French, Sheehan, and Colorado disclosed the information including information indicative of the user indicating good standing with the registration authority (See rejection of claim 1 above and Colorado Section 7).

35. Regarding claim 40, it was inherent that the good standing license information was updated regularly in order for the information to have been useful in determining the status of the license as required by Colorado.

36. Regarding claim 41, the combination of French, Sheehan, and Colorado disclosed recording biometric data (See French Col. 12 Paragraph 4).

37. Claims 23 and 24, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of French, Sheehan, and Colorado, and further in view of Herrmann (U.S. Patent Number 5,995,756) hereinafter referred to as Herrmann.

The combination of French, Sheehan, and Colorado disclosed a method for authenticating users in order to issue a digital certificate involving providing an input form to a user, receiving the completed form and forwarding the digital credentials from the completed form to an authentication server, wherein at least some portions of the electronic input form are to be completed by licensed professional users wherein licensed professional users have a valid license issued by a registration authority (See French Fig. 1, 31-33, and 45, and Col. 14 Paragraph 4 and

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the rejection of claim 6 above), but the combination of French, Sheehan, and Colorado failed to disclose that the input form was digitally signed before providing it to the enrollee.

Herrmann teaches that an electronic application form can be digitally signed before providing the user with the form in order to authenticate the form provider (See Herrmann Col. 7 Paragraph 4).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Herrmann in the method of the combination of French, Sheehan, and Colorado in order to provide a digitally signed form to the user applying for a digital certificate. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the applicant with a guarantee of authenticity of the electronic forms.

38. Claims 6-11, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes et al. ("Handbook of Applied Cryptography") hereinafter referred to as Menezes, and further in view of Sheehan and Colorado.

39. Regarding claim 6, Menezes disclosed receiving a digital credential associated with a user registered with a registration authority. Menezes disclosed acquiring a public-key certificate corresponding to a subject A (See Menezes Page 560 Section ii Lines 5-7) wherein subject A was registered with a certificate authority (See Menezes Page 560 Section i); verifying the identity and registration status of the user, thereby authenticating the digital credential. Menezes disclosed the acquired certificate agreeing with the user identity (See Menezes Page 560 Section ii Line 7). Menezes further disclosed verifying the certificate's timestamp, signature, and that the certificate had not been revoked (See Menezes Page 560 Section ii/4/a-d).

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Menezes also disclosed that this process is used to authenticate the digital certificate (See Menezes Page 560 Section ii/5). However, Menezes failed to disclose the certification authority being for licensed professionals, or the registration status indicating whether the user was authorized to perform one or more restricted activities.

Sheehan teaches a system for a prescribing party to issue a prescription through a communication network such as the Internet, in which the prescribing party includes doctors, health service providers, and other authorized personnel (See Sheehan Abstract and Col. 4 Lines 47-49). However, Sheehan failed to disclose a method for ensuring that the prescribing party was in fact authorized to issue prescriptions.

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Sheehan in the authentication system of Menezes by verifying certificates of authorized prescribing parties. This would have been obvious because the ordinary person skilled in the art would have been motivated to protect patients against illegally issued prescriptions.

Colorado teaches that in order to write a prescription in the state of Colorado, an advanced practice nurse must be listed on the advanced practice registry, have a license in good standing without disciplinary sanctions, and have fulfilled requirements established by the board (See Colorado Section 7).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Colorado in the prescribing party authorization system of Menezes and Sheehan by checking the standing of the medical license of the party, whether they are registered on the advance practice registry, and the status of fulfillment of the requirements

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established by the board. This would have been obvious because the ordinary person skilled in the art would have been motivated to ensure that all legal requirements for issuing prescriptions were fulfilled prior to authorizing the party.

40. Regarding claim 7, the combination of Menezes, Sheehan, and Colorado disclosed verifying the registration status includes accessing a local copy of registration information maintained by the registration authority. Menezes disclosed acquiring the certificate from a central public database and then verifying the timestamp validity period in the certificate (See Menezes Page 560 Section ii/3-4).

41. Regarding claim 8, the combination of Menezes, Sheehan, and Colorado disclosed verifying registration status includes querying the registration authority. Menezes disclosed acquiring the public key of the certification authority in order to verify the information in the certificate (See Menezes Page 560 Section ii/1, 4b-c).

42. Regarding claim 9, the combination of Menezes, Sheehan, and Colorado disclosed verifying the validity of a medical license number (See Colorado Section 7).

43. Regarding claim 10, the combination of Menezes, Sheehan, and Colorado disclosed verifying the signature on the digital credential using a public key of the registration authority (See Menezes Page 560 Section ii/4/c).

44. Regarding claim 11, the combination of Menezes, Sheehan, and Colorado disclosed reporting the result of the verification to the relying party. Menezes disclosed party B (the relying party) accepting the public key in the certificate as authentic depending on the verifying steps performed on the certificate (See Menezes Page 560 Section ii/5). It was inherent that the

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result of the verification was reported to party B in order for the key to be either authenticated or not depending on the result of the verification.

45. Claims 28-32 are rejected for the same reasons as claims 6-10 above and further because it was inherent that computer program instructions were provided for the authentication of the combination of Menezes, Sheehan, and Colorado to function properly in a computer environment.

46. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Menezes, Sheehan, and Colorado as applied to claim 6 above, and further in view of Wobber et al. (U.S. Patent Number 5,235,642) hereinafter referred to as Wobber.

The combination of Menezes, Sheehan, and Colorado disclosed a method of verifying digital certificates and verifying a registration status (See Menezes Page 560 Section ii), but Menezes failed to disclose storing the result of the verification in an activity log.

Wobber teaches that the authentication process can be expedited if the result of the authentication is stored in a record along with the authentication credentials (See Wobber Col. 2 Paragraph 2).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Wobber to the authentication method of the combination of Menezes, Sheehan, and Colorado. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the user with the quickest authentication possible.

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47. Claims 18-19, and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Menezes, Sheehan, and Colorado as applied to claim 6 above, and further in view of AberdeenGroup (Evaluating the Cost of Ownership for Digital Certificate Projects).

The combination of Menezes, Sheehan, and Colorado disclosed centrally authenticating digital credentials issued by a registration authority for licensed professionals, the digital credentials including information indicative of compliance with one or more requirements of the registration authority (See Rejection of claim 6 above and Sheehan Fig. 1 Element 110).

However, the combination of Menezes, Sheehan, and Colorado failed to disclose forming a contract with the relying party and charging for the authentication.

AberdeenGroup teaches that VeriSign, a well-known Certificate Authority for authenticating digital certificates, charges for its services on a time basis (See AberdeenGroup Fig. 1), in which a contract is inherently formed.

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of AberdeenGroup in the authentication system of Menezes, Sheehan, and Colorado by forming a contract with the server and charging for the authentication services. This would have been obvious because the ordinary person skilled in the art would have been motivated to produce revenue from the internet prescription system.

Regarding claim 19, the combination of Menezes, Sheehan, Colorado, and AberdeenGroup disclosed that VeriSign charged on a timed basis (See AberdeenGroup Fig. 1). This constitutes a subscription.

Regarding claim 21, the combination of Menezes, Sheehan, Colorado, and AberdeenGroup disclosed verifying an identity of a user based on the digital credential; and



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verifying a registration status of the user with the registration authority, wherein the registration status as indicative of whether the user is licensed by the registration authority (See the rejection of claim 6 above and Colorado Section 7).

48. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Menezes, Sheehan, Colorado, and AberdeenGroup as applied to claim 18 above, and further in view of Magic, Inc. ("Meteor Security: Some Speculations"), hereinafter referred to as Magic.

The combination of Menezes, Sheehan, Colorado, and AberdeenGroup disclosed charging a subscription fee for an authentication service utilizing digital certificates (See AberdeenGroup Fig. 1), but failed to disclose the possibility of charging on a use-by-use basis.

Magic teaches that if the number of financial and school partners is low, then it would be cost-effective to use ACES certificates for communication security (See Magic Page 3 Paragraph 3). Magic further teaches that ACES certificates charge a per use transaction fee (See Magic Paragraph 2 Line 1).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Magic to the method of the combination of Menezes, Sheehan, Colorado, and AberdeenGroup in order to charge for the use of digital certificates. This would have been obvious because one of ordinary skill in the art would have been motivated to provide a cost-effective way to provide the security of digital certificates to a user.

49. Claim 22 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Menezes, Sheehan, Colorado, and AberdeenGroup as applied to claim 18 above, and further in view of Matonis ("User-Friendly Digital Signatures"), hereinafter referred to as Matonis.

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The combination of Menezes, Sheehan, Colorado, and AberdeenGroup disclosed a subscription based authentication service utilizing digital certificates (See AberdeenGroup Fig. 1), but failed to disclose requiring the communications between users to be required in the contract.

Matonis teaches that in order to guarantee authentication of a sender, the use of digital signatures must be enforced (See Matonis Page 26).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Matonis to the method of the combination of Menezes, Sheehan, Colorado, and AberdeenGroup in order to enforce the use of digital signatures by requiring it in the contract. This would have been obvious because the ordinary person skilled in the art would have been motivated to guarantee the authentication of a sender to a receiver.

50. Claims 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of French, Sheehan, Colorado, and Herrmann, as applied to claim 23 above, and further in view of the combination of Menezes Sheehan, and Colorado.

Regarding claim 34, the combination of French, Sheehan, Colorado, and Herrmann disclosed a method for issuing digital certificates indicating that the user is a licensed professional to users (See rejection of claim 1 above), but the combination of French, Sheehan, Colorado, and Herrmann failed to disclose how the digital certificates are verified once they have been issued.

The combination of Menezes, Sheehan, and Colorado teaches that when a digital certificate is used, a certification authority verifies the uses of the certificate (See Menezes Page 560 Section ii).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of the combination of Menezes, Sheehan, and Colorado in the method of French in order to authenticate the use of a digital certificate. This would have been obvious because the ordinary person would have been motivated to provide authentication of the certificates it issued, as is inherently necessary in the use of digital certificates.

Claim 35 recites recording the uses of the digital credential at the authentication service (See French Col. 5 Paragraph 6).

Claim 36 is rejected for the same reasons as claim 6 and 11 above as applied to claim 35.

Claim 37 recites a plurality of relying parties (See Menezes Page 559 Section 13.4.2 Paragraph 1).

Claim 33 is rejected for the same reasons as claims 23, 35, and 37 above.

### *Response to Arguments*

51. Applicant's arguments filed 09/28/2004 have been fully considered but they are not persuasive. Applicant traverses primarily that:

I. The ordinary person skilled in the art would have been able to determine the scope of a “substantially regular basis”.

II. The applied prior art did not disclose the registration information including a registration status indicating whether the user is in compliance with one or more requirements of the registration authority.

III. A driver's license is not a professional license.

52. Regarding argument I. the examiner has considered the argument and finds that it is not persuasive. Although, in certain instances, the use of the term “substantially” does not render the

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scope of claim indefinite, the examiner believes that in this particular instance, the use of the term substantially does, in fact, render the scope of the claim indeterminate. This is due to the fact that one of ordinary skill in the art would be unable to determine whether updating the status on a “substantially regular basis” is limited to once every day, once every week, once every month, once every year, once in a lifetime, once in a millennium, or even once every infinite number of years. Because the ordinary person skilled in the art would be unable to determine the limit of a “substantially regular basis”, the ordinary person skilled in that art would not be able to determine the scope of the claim. Therefore, the rejection that claim 40 fails to particularly point out and distinctly claim the subject matter which the inventor regards as the invention, and therefore fails to meet the requirements of 35 USC 112 second paragraph. Therefore, the examiner maintains the 112 second rejection of claim 40.

53. Applicant's arguments II, and III with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

54. Regarding the enablement rejections presented above, the limitations added to these claims were not previously presented, either in the specification or in the claims as originally filed. These limitations were not supported by the specification as originally filed. Therefore there is no evidence that the inventor possessed the invention as claimed at the time of filing. Therefore, this subject matter is not allowable.

*Conclusion*

55. Claims 1-41 have been rejected.

56. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

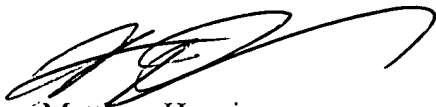
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Henning  
Assistant Examiner  
Art Unit 2131  
1/19/2005



**ANDREW CALDWELL**  
**SUPERVISORY PATENT EXAMINER**